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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,040	02/06/2004	Justin T. Ernst	060621-0703	4994
30542	7590	10/04/2006	EXAMINER	
FOLEY & LARDNER LLP			KEYS, ROSALYND ANN	
P.O. BOX 80278			ART UNIT	
SAN DIEGO, CA 92138-0278			PAPER NUMBER	

1621

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/774,040

Applicant(s)

ERNST ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 5,24,33,35,40,41,44,46-49,61-65 and 67-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-23,25-32,34,36-39,42,43,45,50-60 and 66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-86 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-86 are pending.

Claims 1-4, 6-23, 25-32, 34, 36-39, 42, 43, 45, 50-60, and 66 are rejected.

Claims 5, 24, 33, 35, 40, 41, 44, 46-49, 61-65 and 67-86 are withdrawn from further consideration.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on July 2, 2004 has been considered by the examiner.

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

Inventor Susana C. Ceide did not include the date upon which she signed the oath.

### ***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-66, drawn to a compound and pharmaceutical composition, classified in classes 546, 548, 549, 560, 562, 564, 568, 585 etc., subclass various.
  - II. Claims 67-72, drawn to a method for the treatment of a viral infection and a method for the inhibition of cell entry by a virus, classified in class 514, subclass various.
  - III. Claims 73-82, drawn to a method of preparing a compound of claim 2, classified in class 546, 548, 549, 560, 562, 564, 568, 585 etc., subclass various.

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- IV. Claims 83-85, drawn to a method of preparing a compound of claim 2 wherein X' is CH<sub>2</sub>, classified in class 546, 548, 549, 560, 562, 564, 568, 585 etc., subclass various.
- V. Claim 86, drawn to an intermediate having the formula III, classified in class 546, 548, 549, 560, 562, 564, 568, 585 etc., subclass various.

The inventions are distinct, each from the other because of the following reasons:

- 5. Inventions I and V are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as an antioxidant (see US Patent No. 1,778,548) and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.
- 6. Inventions II, III and IV are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a different mode of operation. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.
- 7. Inventions III-IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the intermediate compound of Formula III can be used in a materially different process of using that product, for example it can be use as an antioxidant (see US Patent No. 1,778,548).
- 8. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have

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acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Claims 1-86 are generic to the following disclosed patentably distinct species: 13, 15, 17 etc. The species are independent or distinct because a prior art reference anticipating the claims with respect to one of the species would not render the claim obvious under 35 U.S.C. 103 with respect to the other species. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. During a telephone conversation with Barry S. Wilson on September 26, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-66 and species Compound No. 5 in example 11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 67-86 are withdrawn from further consideration by the examiner, pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 5, 24, 33, 35, 40, 41, 44, 46-49, 61-65 are within the elected Group I, however since no prior art has been found that anticipates or renders obvious the elected species compound 5, the search of the Markush-type claim was extended. Prior art has been found that anticipates the Markush-type claim with respect to a nonelected species, thus claims 5, 24, 33, 35, 40, 41, 44, 46-49, 61-65 drawn to the nonelected species are held withdrawn from further consideration.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of

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inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. Claims 1-4, 6-23, 25-32, 34, 36-39, 42, 43, 45, 50-60, and 66 are rejected under 35 U.S.C. 102(a) as being anticipated by Hamilton et al. (US 2003/00088882 A1).

Hamilton et al. disclose the instant claim compound and pharmaceutical composition (see entire disclosure, in particular compound n in figure 17 and paragraph 00006).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 2, 9-15, 17-20, 25, 36-39, 42, 43, 45, 50-55 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Connor et al. (WO 99/32433).


Connor et al. disclose the instant claim compound and pharmaceutical composition (see entire disclosure, in particular compounds VII and VIII on pages 26 and 27).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynn Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M-W & F 5:30-8:30 am & 1-5 pm; Th 5:30 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Rosalynd Keys  
Primary Examiner  
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September 28, 2006